REMARKS

Claims 1-47, as amended by Applicants' May 17, 2004 Amendment and Response to Office Action, are currently pending in the present application. No claims have been canceled or further amended in this Response. Reconsideration of the above-identified patent application is hereby requested in view of the following Remarks and the supporting Declarations and Exhibits referred to therein.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-7, 11-18, 22, 23, 25-27, 29, 30, 32-34, 36, 37, 39-41, 43, 44, 46 and 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,252,883, issued to Schweickart et al. ("Schweickart"), in view of Uchida et al. WO 00/68913 (priority document of U.S. Patent 6,696,956)("Uchida"). Applicants initially note that the Examiner appears to have mistakenly characterized WO 00/68913 as the priority document of U.S. Patent 6,252,883 (Schweickart). March 17, 2005 Action, Page 2, para. 4. Further, all of the Examiner's citations to the English teachings of Uchida cite U.S. Patent 6,252,883 (Schweickart). March 17, 2005 Action, pages 3, 5 and 6, para. 4. Applicants believe the Examiner intended to cite U.S. Patent 6,696,956, the U.S. National Stage Patent of priority document WO 00/68913. As such, for purposes of these Remarks, Applicants assume that all references to the English teachings of Uchida are intended to be references to U.S. National Stage Patent 6,656,956.

With regard to claims 1, 12, 46 and 47, the Examiner acknowledges that Schweickart does not specifically teach the personal data comprising step data corresponding to a number of steps counted during an activity of the user. March 17, 2005

Action, Page 3, para. 4. However, employing the factual inquiries for determining obviousness set forth in Graham v. John Deere Co., the Examiner goes on to conclude that "Uchida teaches of a personal communications device which is able to receive personal data of a user and wherein the personal data comprises step data corresponding to a number of steps counted during an activity of the user. . . . Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schweickart by counting the number of steps counted during an activity of the user as taught by Uchida. March 17, 2005 Action, Pages 2-3, paras. 3-4 (citing the 4 factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) in analysis of prior art). Applicants respectfully traverse.

According to 37 C.F.R. § 1.131(a), the effective date of the Uchida reference, for prior art purposes, is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. § 102(e). However, since Uchida was filed prior to November 29, 2000, it cannot properly be applied as prior art under 35 U.S.C. § 102(e) and, therefore, can only be applied as prior art under 35 U.S.C. § 102(a) as of its publication date, November 16, 2000. *See* MPEP § 2136.03(II)(C)(2). Accordingly, where the applicants can demonstrate a date of invention that predates Uchida's November 16, 2000 effective date, the reference is eliminated as support for the rejection. In re Application of Eickmeyer, 602 F. 2d 974, 978 (CCPA 1979). Prior invention may be established by proof of actual reduction prior to the effective date of the reference or conception prior to the effective date of the reference, coupled with due diligence from prior to said date to a subsequent actual or constructive reduction to practice. 37 C.F.R. § 1.131(b).

Pursuant to these principals, Applicants respectfully submit that Uchida must be eliminated as support for the Examiner's rejection of claims 1, 12, 46 and 47 because the subjected matter thereof, including the element of receiving personal data of a user wherein the personal data comprises step data corresponding to a number of steps counted during an activity of the user, was invented by the Applicants prior to the November 16, 2000 effective date. More specifically, Applicants conceived the subject matter of the respective claims prior to the effective date of Uchida and exercised due diligence in the preparation and execution of the application from before said date through constructive reduction to practice on January 8, 2001. Therefore, at the time the invention described claims 1, 12, 46 and 47 was made, the subject matter, as a whole, would not have been obvious to one of ordinary skill in the art.

With regard to conception, it is axiomatic that "conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice." *See, e.g.*, Cooper v. Goldfarb, 240 F. 2d 1378, 1382 (Fed. Cir. 2001); Ethicon, Inc. v. U.S. Surgical Corp., 135 F. 3d 1456, 1460 (Fed. Cir. 1998)(quoting Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F. 2d 1367, 1376 (Fed. Cir. 1986). Thus, the test for conception is whether or not the inventor(s) can point to evidence corroborating possession of an idea sufficiently developed as to represent a definite, particular invention. *See* Burroughs Wellcome Co. v. Barr Laboratories, Inc., 40 F. 3d 1223, 1228 (Fed. Cir. 1994).

In the present matter, Applicants were in possession of the idea for the particular invention described in each of the above-referenced claims prior to publication of the Uchida

reference. The enclosed Declarations and supporting documentation corroborate such possession. First, Both Applicants attest, under of penalty of perjury, that by at least late October 2000, they had conceived of the complete invention described in the respective claims, including the element of receiving personal data of a user by at least one personal parameter receiver, the personal data comprising step data corresponding to the number of steps counted during an activity of the user. Declaration under 37 C.F.R. § 1.131, Declaration of Deane Gardner at ¶ 3 (hereinafter "Gardner Declaration"). Applicants' patent counsel confirms that such conception occurred at least prior to November 16, 2000. Declaration of Marina Portnova, Esq. at ¶ 4 (hereinafter "Portnova Declaration").

In addition, Applicants contend that documentation offered in support of the above cited Declarations corroborate conception of the entire subject matter described in claims 1, 12, 46 and 47 prior to the effective date of Uchida. First, email correspondence from Applicant Deane Gardner to patent counsel dated October 20, 2000 illustrates possession of the idea for including a personal parameter receiver for receiving step data corresponding to the number of steps counted during an activity of the user. Indeed, in describing the function of the present invention, Gardner explains that:

> [t]he user feedback display might be on a cell phone, too, in addition to over a normal web browser. The user could use a microbrowser to view a WAP version of his/her normal web pages, or just read out on the cell phone display how may ***step***/miles/calories he/she has gone today, or heart rate, ect. without going to the web page.

Exhibit F to Portnova Declaration(emphasis added).

Subsequent to the above cited email correspondence, Gardner further illustrated the invention described in claims 1, 12, 46 and 47 via a hand drawn sketch, which was faxed to patent counsel on November 6, 2000. Exhibit G to Portnova Declaration. The sketch shows a personal parameter receiver integrated into a "cell phone, PDA or combination cell phone PDA". Further, the cell phone, PDA or combination thereof includes a microprocessor and memory for receiving and storing personal data.

Finally, on November 9, 2000, patent counsel provided Applicants with draft copies of the '241 application specification and the supporting drawings via email. Exhibit G to Gardner Declaration. Referring to the draft drawings, (Exhibits A-E of the Portnova Declaration) Applicants first note that the drafts correspond to the exact drawings filed in support of the '241 application. Above cited Exhibits A-E correspond respectively to FIGS 1B, 1C, 2, 3 and 4 of the '241 application.

Turning the Examiner's attention to Exhibit B of the Portnova Declaration, it can be seen that, by at least November 9, 2000, applicants possessed the idea for the specific invention described in claims 1, 12, 46 and 47. The drawing, which corresponds to FIG. 1C of the '241 application, shows a personal parameter receiver **225** integrated into a device suitable for communication over a wireless network **120** (e.g., a personal computing device, a wireless communications device or combination thereof). The device includes a microprocessor **110** coupled to a memory **116** and software program **282**. Personal data, including step data corresponding to a number of steps counted during an activity of a user, is outputted to the microprocessor **110** in response to a signal caused by execution of software **282** and is captured and stored in the device memory

116. *See* Exhibit F to Portnova Declaration (explaining that personal data captured by the invention includes step data).

Likewise Exhibits D and E of the Portnova Declaration corroborate Applicants' conception of the above referenced claims prior to Uchida. Exhibit D, which corresponds to FIG. 3 of the '241 application, is a flow diagram of the method for integrating personal data capturing functionality into a wireless communications device. At step **304**, personal data, which, as noted above, includes step data corresponding to a number of steps counted during an activity of a user, is received by at least one Personal Parameter Receiver. That data is subsequently captured and stored in the memory of the device **306**. Exhibit E, which corresponds to FIG. 4 of the '241 application, illustrates the same method in relation to a portable computing device.

Next, with respect to diligence, it is well established that the question of whether or not an Applicant exercised due diligence in filing a patent application is subject to the "rule of reason." Gould v. Schawlow, 363 F. 2d 908, 921 (CCPA 1966); D'Amico v. Koike, 347 F. 2d 867, 871 (CCPA 1965). An inventor can demonstrate reasonable diligence towards actual or constructive reduction to practice of an invention via affirmative acts or acceptable excuses. Griffith v. Kanamaru, 816 F.2d 624,626-7(Fed. Cir. 1987); MPEP § 2138.06 (citations omitted). In evaluating the acceptability of an excuse, consideration must be given to the reasonable everyday problems and limitations encountered by an inventor. Griffith, 816 F.2d at 626(Fed. Cir. 1987). For example, reasonable delay resulting from an inventor's daily job demands is acceptable. *See* Courson v. O'Connor, 227 F. 890, 890 (7th Cir. 1915)("[r]easonable diligence in preparing and filing his application does not require an inventor to devote his entire time thereto, or to

abandon his ordinary means of livelihood.") Likewise, it is not inexcusable for one who has worked with another to produce jointly a single inventive concept to wait for the other's availability in order to jointly review an application for patent dealing with that inventive concept. Reed v. Tornqvist, 436 F. 2d 501, 504 (CCPA 1971).

Reasonable diligence is all that is required of the attorney as well. Bey v. Kollonitsch, 806 F.2d 1024,1027 (Fed. Cir. 1986)(citation omitted). Reasonable diligence is established if attorney worked reasonably hard on the application during the critical period. *Id.* If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. *Id.*

In the present application, Applicants and patent counsel exercised reasonable diligence under the circumstances from prior to the publication of the Uchida reference to January 8, 2001, when the invention was constructively reduced to practice in the form of an application submitted to this Office for examination. Looking first at the period before the November 16, 2000 publication of Uchida, the Declarations of the inventors and patent counsel discussed above, along with the documents referenced therein corroborate that, prior to Uchida, Applicants and patent counsel were engaged in work directly related to reduction to practice of the invention. For instance, the October 20, 2000 email from Applicant Deane Gardner to patent counsel expressly addresses questions propounded by patent counsel for purposes of obtaining sufficient information to draft the specification of the '241 application. (Exhibit F to the Portnova Declaration).

Additionally, Gardner's draft sketch of the invention faxed to patent counsel on November 6, 2000, was provided for purposes

of aiding patent counsel compose the drawings that were ultimately provided in support of the '241 application. (Exhibit G to Portnova Declaration). The cover letter accompanying the fax indicates that Gardner experienced some delay in transmission of the drawing to counsel. However, this delay is explained in Gardner's Declaration under 37 C.F.R. § 1.131, wherein he states that he originally advised counsel that the sketch would be provided on November 3, 2000, but was delayed in transmitting the document until November 6, 2000 due to the demands of his day to day job responsibilities. Gardner Declaration at ¶ 4.

Patent counsel also exercised due diligence towards constructive reduction to practice prior to Uchida, as evidenced by the affirmative actions taken by counsel prior to November 16, 2000. Applicants first began working with patent counsel on the '241 application in late October 2000. Gardner Declaration at ¶ 3. On October 20, 2000 counsel sent an email to Gardner requesting further explanation of the invention to aid in drafting the '241 application. Exhibit F to Portnova Declaration. Soon thereafter, On November 9, 2000, counsel was able to complete a draft of the '241 application and drawings for review by Applicants. Exhibit G to Gardner Declaration.

With respect to the Applicant' diligence from publication of Uchida to constructive reduction to practice of the invention, Applicants first respectfully note that the Examiner appears to have erroneously listed the filing date of the '241 application as March 13, 2001. *See* March 17, 2005 Action cover sheet. Accordingly, Applicants wish to make clear that the correct filing date of the '241 application is January 8, 2001. After the '241 application was filed and granted a filing date of January 8, 2001, a subsequent duplicate filing receipt was sent to patent counsel following submission of a timely response

to a Notice to File Missing Parts. Portnova Declaration at ¶ 3. The duplicate filing receipt listed the filing date of the '241 application as March 13, 2001, the date patent counsel filed the response to the Notice to File Missing Parts. *Id.* As explained in the Portnova Declaration, patent counsel immediately recognized the erroneous filing date and timely filed a Request for Corrected Filing Receipt, wherein counsel requested correction of the filing receipt to reflect the filing date as January 8, 2001. *Id.* That request was acknowledged by the United States Patent and Trademark Office on June 18, 2001. *Id.*

Next, as discussed above, patent counsel provided Applicant Deane Gardner with a draft of the '241 application and drawings specification for review on November 9, 2000. Exhibit G to Gardner Declaration. Gardner reviewed the documents with no more than the usual interruptions and delays for the normal demands of his day-to-day job responsibilities. Gardner Declaration at ¶ 6. Upon careful review of the draft specification and drawings, and subsequent to the publication of Uchida, Gardner again conferred with patent counsel to discuss additional embodiments and modifications to be made to the application before filing. As evidenced by the change in figure numbers of the draft drawings upon filing the finalized '241 application, Applicants and patent counsel decided to modify the draft application to further include FIG 1A and FIG. 5. *Compare* Exhibits A-E to Portnova Declaration, *with* FIGS. 1A-5 of the '241 application.

Accordingly, patent counsel thereafter made the appropriate changes and filed the '241 application and specification with no more than the usual interruptions for holidays (Thanksgiving, Christmas and New Years) and the demands of her other clients. Portnova Declaration at ¶ 7. That such modifications to the '241 application ultimately delayed the filing of the

application until January 8, 2001 does not amount to a lack of diligence, particularly where, as here, such delay is accounted for by Declaration and supporting documentation.

To be sure, in the long-standing case of Courson v. O'Connor, 227 F. 890 (7th Cir. 1915), the Seventh Circuit reversed the lower courts affirmance of an Examiner's finding of a lack of diligence on the part of the inventor, notwithstanding an unexplained three (3) month delay between actual reduction to practice and filing of the application. *Id.* at 892-4. On appeal, the court considered new evidence of diligence, which indicated that the delay was attributable, at least in part, to "the usual delays incident to the services of a busy patent solicitor". *Id.* at 894. According to the court, such delay was excusable since, "[t]he law does not require [an inventor] to employ an experienced patent draftsman in lieu of one thoroughly competent, but unable, because of other work and inexperience, to get the matter done with exceeding promptness." *Id.*

In view of the foregoing discussion and the Declarations and supporting documents enclosed herewith, Applicants submit that the Uchida cannot properly be combined with the teachings of Schweickart to render the above-referenced claims obvious. Thus, Applicants assert that the § 103 rejection is overcome and respectfully request that the rejection be withdrawn.

Regarding claims 2-7, 11 and 13-18, Applicants note that each of these claims, by virtue of being dependant on claims 1 and 12 addressed above, also contain the limitation of receiving personal data of a user by at least one personal parameter receiver, the personal data comprising step data corresponding to a number of steps counted during an activity of a user. Therefore, as with claims 1, 12 46, and 47, Uchida cannot be combined with the teaching of Schweickart to render the above

referenced claims obvious because Applicants invented the subject matter of the claims prior to November 16, 2000, the effective date of Uchida. Applicants hereby incorporate the discussion of Applicants prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 as if set forth in its entirety. Accordingly, Applicants submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

Regarding claims 22, 29, 36 and 43, Applicants note the each of these independent claims include the element cited by the Examiner as being anticipated by the Uchida reference, namely receiving personal data comprising step data corresponding to a number of steps counted during an activity of the user. As discussed above with respect to claims 1, 12, 46 and 47, Uchida cannot be properly combined with the teachings of Schweickart to render the above referenced claims obvious because Applicants invented the subject matter of the claims prior to the effective date of the Uchida reference. Applicants hereby incorporate the discussion of prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 herein as if set forth in its entirety. Accordingly, applicants submit that the § 103 rejection has been overcome and respectfully request that the rejection be withdrawn.

Regarding claims 23, 30, 37 and 44, Applicants note that each of these claims, by virtue of being dependant on claims 22, 29, 36 and 43, contain the limitation of receiving step data corresponding to the number of steps counted during an activity of a user. Therefore, as with claims 22, 29, 36 and 43, Uchida cannot be combined with the teaching of Schweickart to render the above referenced claims obvious because Applicants invented

the subject matter of the claims prior to November 16, 2000, the effective date of Uchida. Applicants hereby incorporate the discussion of Applicants prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 as if set forth in its entirety. Accordingly, Applicants submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

Regarding claims 25, 32 and 39, Applicants note the each of these independent claims include the element cited by the Examiner as being anticipated by the Uchida reference, namely receiving personal data comprising step data corresponding to a number of steps counted during an activity of the user. As discussed above with respect to claims 1, 12, 46 and 47, Uchida cannot be properly combined with the teachings of Schweickart to render the above referenced claims obvious because Applicants invented the subject matter of the claims prior to the effective date of the Uchida reference. Applicants hereby incorporate the discussion of prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 herein as if set forth in its entirety. Accordingly, applicants submit that the § 103 rejection has been overcome and respectfully request that the rejection be withdrawn.

Regarding claims 26, 33 and 40, Applicants note that each of these claims, by virtue of being dependant on claims 25, 32, and 39, contain the limitation of receiving step data corresponding to the number of steps counted during an activity of a user. Therefore, as with claims 25, 32, and 39, Uchida cannot be combined with the teaching of Schweickart to render the above referenced claims obvious because Applicants invented the subject matter of the claims prior to November 16, 2000, the

effective date of Uchida. Applicants hereby incorporate the discussion of Applicants prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 as if set forth in its entirety. Accordingly, Applicants submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

Regarding claims 27, 34 and 41, Applicants note that each of these claims, by virtue of being dependant on claims 25, 32, and 39, contain the limitation of receiving step data corresponding to the number of steps counted during an activity of a user. Therefore, as with claims 25, 32, and 39, Uchida cannot be combined with the teaching of Schweickart to render the above referenced claims obvious because Applicants invented the subject matter of the claims prior to November 16, 2000, the effective date of Uchida. Applicants hereby incorporate the discussion of Applicants prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 as if set forth in its entirety. Accordingly, Applicants submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

Regarding claims 8-10, 19-21, 24, 28, 31, 35, 38, 42 and 45, the Examiner has rejected each claim under 35 U.S.C. § 103 as being unpatentable over Schweickart in view of Uchida and further in view of Goodman. According to the Examiner, "Schweickart does not specifically teach of displaying the information to the user. However, Schweickart suggests of displaying the information to medical personnel or other individuals therefore, it would have been obvious to display the information to the user so that the user will know their current medical status." March 17, 2005 Action, page 7, para. 5.

Further, "Goodman teaches that it was well known in the art to monitor a user with a personal communication device and to generate information pertaining to personal data and to display the information on the display of the personal communication device." *Id.* (citing Goodman abstract; fig. 2; col. 2, lines 61-65; col. 4, lines 45-62). Therefore, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Schweickart and Uchida by displaying the information to the user on their personal communication device as taught by Goodman". March 17, 2005 Action, page 7, para. 5.

Applicants note that each of the above referenced claims include the limitation cited by the Examiner as being anticipated by the Uchida reference, namely receiving step data corresponding to the number of steps counted during an activity of the user. Consequently, as with all of the other claims of the '241 application, Applicants assert that Uchida cannot be combined with other prior art to render the above referenced claims obvious because Applicants invented the subject matter of the respective claims prior to November 16, 2000, the effective date of Uchida. Applicants hereby incorporate the discussion of Applicants prior conception and due diligence set forth above with respect to claims 1, 12, 46 and 47 as if set forth in its entirety. Upon removal of Uchida, the combination of Schweickart and Goodman does not anticipate every element of the above referenced claims and, therefore, does not render the invention described in the respective claims obvious. Thus, Applicants respectfully submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

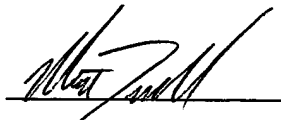
Applicants further state that, in view of the fact that they invented the claims at issue prior to the Uchida reference,

it is not necessary to further respond to the characterizations of the prior art set forth by Examiner in the Office Action. However, nothing contained herein should be construed in any way as an admission by Applicants that they agree with any of the characterizations of the teachings of any of the references at issue in the Office Action, or with any asserted motivations to combine references together. Any and all such arguments by Applicants are expressly reserved in view of Applicants' reliance upon 37 C.F.R. § 1.131.

CONCLUSION

In view of the foregoing Remarks and the Declarations and supporting documents submitted herewith, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,



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